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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1936.

No. 785.

THE MANTLE LAMP COMPANY OF AMERICA,
Petitioner,

vs.

ALUMINUM PRODUCTS COMPANY.
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1936.

No. 765.

THE MANTLE LAMP COMPANY OF AMERICA,
Petitioner,

vs.

ALUMINUM PRODUCTS COMPANY.
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

I.

Opinions in the Court Below.

The opinion of the District Court, embodied in the Findings of Fact and Conclusions of Law filed by Judge John P. Barnes on March 13, 1934; is not reported but appears in the record on pages 321 to 325.

The opinion of the Circuit Court of Appeals is reported in 86 Fed. (2d) 509, was filed November 28,

1936, and appears in the record on pages 493 and 494.

The opinion of this court on questions certified to it by the Circuit Court of Appeals appears in 297 U. S. 638, 646; 56 S. Ct. 645, 649. The order dismissing the certificate is found on page 488 of the record.

II.

Grounds for Jurisdiction.

Jurisdiction is invoked by petitioner under Section 240 (a) of the Judicial Code (28 U. S. C. A. 347 as amended) because of alleged diversity of opinion between Circuit Courts of Appeals; because the decision below is in alleged conflict with the weight of authority and because the Circuit Court of Appeals below did not pass upon the disclaimer questions previously certified to this court.

Respondent's position is that the facts below were contested, that both courts concurred in finding these facts were not sufficient to warrant a reversal of the decisions in the Macomb and Monarch suits, and that the writ of certiorari is requested merely to review this fact testimony.

Questions of fact do not appear among the special and important reasons for a review on writ of certiorari as given in Rule 38, paragraph 5, of the Supreme Court Rules. Both courts below concurred in finding that the facts testified to by these witnesses, as changed by the circumstances in this case, were not sufficient to cause a reversal of the decisions in the Macomb and Monarch suits. This court is asked to grant this discretionary writ to review this fact testimony. That such is at variance with the practice of this court see—

Continental Paper Bag Co. v. *Eastern Paper Bag Co.*, 210 U. S. 405; 28 S. Ct. 748, 750.

Boehmer v. *Pennsylvania Ry. Co.*, 252 U. S. 496; 40 S. Ct. 409.

Chicago Junction Railway Co. v. *King*, 222 U. S. 222; 32 Sup. Ct. 79.

The question of disclaimers is moot.

The judgment sought to be reviewed was entered November 28, 1936 (Rec. 494).

III.

Statement.

With the exception of certain conclusions the Statement of petitioner (Brief, p. 13), as embodied in the Petition for Writ of Certiorari, is proper and correct.

The argumentative assumption of petitioner (Pet., p. 6) that the Circuit Court of Appeals for the Seventh Circuit, "postulating validity" certified certain questions to this court is unwarranted. From the nature of the questions certified it is obvious to respondent that the Court of Appeals was inquisitive whether the case should be determined upon the question of disclaimer without passing upon the question of validity as was done in the case of *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 476; 51 S. Ct. 206.

Having found all of the claims invalid in the present suit the Court of Appeals had no reason to pass upon the question of disclaimers. This was sufficient to affirm the decree and the disclaimer question became moot.

IV.

Summary of Argument.

1. Questions of fact concurred in by the courts below do not warrant a review by writ of certiorari.

2. The claims in suit of the Blair patent are invalid.

3. Lack of invention properly may be based upon a review of the prior art.

4. As limited by the prior art there is no infringement.

5. The question of failure to file disclaimer became moot upon the judgment that all the claims in suit were invalid.

V.

ARGUMENT.

1.

Questions of Fact Concurred in by the Courts Below Do Not Warrant a Review by Writ of Certiorari.

In the Sixth Circuit decision, 53 Fed. (2d) 441, the question of validity turned upon the testimony of two fact witnesses, Brainard and Terry, who were not subjected to cross-examination. The defendant had disappeared from the case after answering the bill of complaint and was not represented at the trial. All the proceedings were conducted by the plaintiff. In the present suit these same witnesses were again present but subjected to cross-examination. Evidence in rebuttal of their testimony also was offered along with additional prior art.

The real ground upon which petitioner seeks the writ in this case is whether or not the Circuit Court of Appeals for the Seventh Circuit should have reversed

the District Court on the fact testimony of the witnesses Brainard and Terry. Petitioner argues that it was the evidence adduced by these witnesses which caused the Circuit Court of Appeals for the Sixth Circuit to find claim 1 of the Blair patent to be valid. (Brief, 18.) As to the testimony of these witnesses, that court (Rec. 227) said:

> "It may well be noted that the testimony of two competitors, showing their unsuccessful efforts to get Blair's result by other means, was not in these McComb and Monarch records, and this proof is so important that it alone goes far toward justifying a different result here."

After due consideration of the Brainard and Terry testimony in the present suit, the Circuit Court of Appeals for the Seventh Circuit (Rec. 494) said:

> "There was a difference in the evidence submitted in the Bowman case and in the case at bar from that presented in the McComb and Monarch cases. It consisted of the testimony of witnesses Brainard and Terry who did not testify in the last named cases.
>
> "Although the validity of this patent is a close question, we are not convinced that the additional testimony is sufficient to warrant us in departing from the former ruling of this court in the Macomb and Monarch cases."

Judge Barnes in the District Court, in making his findings (Rec. 324) also said:

> "34. The alleged new evidence is not of such a character as to show clearly and satisfactorily that the decision of the court in this case should be different from that of the Circuit Court of Appeals for the Seventh Circuit in the McComb and Monarch cases.
>
> "35. The alleged new evidence is not of such a character as clearly to require a different decision

> by this court in this case than was made by the Circuit Court of Appeals for the Seventh Circuit when it found in the Macomb and Monarch cases that the structure of Blair was a product of mechanical skill in view of the disclosures in the Clisbee, Fox and Heath patents, and not of inventive genius."

Both the District Court and the Appellate Court in the present suit concurred in refusing to accept the testimony of Brainard and Terry as sufficient basis for departing from the decisions in the Macomb and Monarch cases and it is such ruling of the Circuit Court of Appeals of the Seventh Circuit which petitioner urges as the basis for the grant of the writ.

The Courts in the Present Suit Had the Advantage of Cross-Examination Lacking in the Sixth Circuit Plus Additional Prior Art and Testimony.

The record in the present suit is as different from that of the Sixth Circuit suit as the latter was from the earlier Macomb and Monarch suits in the Seventh Circuit. To adduce new evidence in the Sixth Circuit on validity, petitioner brought in the witnesses Brainard and Terry to testify as to their ignorance of how to make a good jug even when the Blair jug was before them. In the absence of cross-examination, this testimony seemed to be impressive in the Sixth Circuit. The defendant had filed its answer and lost interest in the suit, 53 Fed. (2d) 441, 442. Consequently, petitioner represented not only itself but the defendant too by putting in evidence the prior art cited in the answer.

In the present suit the witnesses Brainard and Terry were again called by petitioner but their testimony was

considerably softened in spots and radically changed in others through cross-examination and the testimony of other witnesses produced by respondent who knew the facts of the situation.

The Sixth Circuit Record of Brainard and Terry was that they failed even with the Blair invention before them and did not succeed until they had copied it. (Rec. 225, 53 Fed. (2d) 441, 444.)

The Seventh Circuit Record of Terry is that his company did not attempt to copy but merely supported a solid walled jug in the container as it had previously supported the vacuum walled jug. (Rec. 62, 65.) Instead of a failure this jug went into production and was made by the carload (Rec. 65). It was neither a copy of Blair nor a failure.

The Seventh Circuit Record of Brainard (Rec. 46-59) was primarily that he could not remember. There is nothing in the record, pages 46-48, cited by petitioners (Brief, p. 18) to show that jugs made by him were failures or that he copied the Blair invention. Three of his former employees were in court during his testimony and this may have accounted for his failure to live up to the expectations of the Sixth Circuit evidence.

The three employees were Amerine, Asbell and Wright. Their testimony shows the development of the Macomb jug that was charged to infringe the Blair patent in an earlier suit (22 Fed. (2d) 93) and which is almost exactly similar to respondent's jug.

The first jug of Macomb was like the drawing at page 249 of the record. The neck of the outer jacket was crimped into a groove in the neck of the inner jug, suspending the latter therefrom. The Heath prior art structure (Rec. 356) shows this same suspension of a

container by an interlock at the neck. The Macomb jug used plaster of Paris and cement on the outside of the jacket to seal the junction at this interlock. In use this plaster of Paris was exposed and would chip off, permitting the insulating ground cork to escape. (Rec. 87, 88.)

To remedy this, Macomb merely placed the plaster of Paris on the inner side of the outer jacket (Rec. 88, 94) as in the drawing at page 251 of the record. This was a successful jug and lacked only appearance to equal any of the present day jugs. But the customers wanted a better looking jug (Rec. 89).

The appearance was remedied by bringing the neck of the outer jacket up over the neck of the inner container as in the drawing on page 253 of the record. The cement was used as a mechanical interlock between the grooves in the neck of the inner container and the screw threads in the neck of the outer jacket as in Steel (Rec. 390) and all present day jugs. The screw threads on the neck of the outer jacket were to support a cup (Rec. 95).

These slight changes, made step by step from Heath through Steel as done by Macomb, do not spell invention in the Blair device. The first jugs with the cement outside were as efficient as the present day jugs. They were not failures (Rec. 95).

Hollister v. *Benedict & Burnham Mfg. Co.*, 113 U. S. 59; 5 S. Ct. 717, 723, 724.

This additional testimony plus the Steel patent plus the cross-examination of petitioner's witnesses not only brought the Sixth Circuit record back to the record in the Macomb and Monarch suits in the Seventh Circuit but carried the record still further on the swing toward invalidity.

2.

The Claims in Suit of the Blair Patent Are Invalid.

Petitioner's attitude toward the Blair patent and the prior art is analogous to the attitude of a fond parent toward his own child and the children of others. The one is wholly good while the others are wholly bad. The present day jug is a good jug and useful, otherwise respondent would not make and sell it. But as is apparent from the record, the steady improvement to the present time was not a matter of invention by anyone but was the development of skilled mechanics who did the obvious things from what was taught in the art.

The heat insulated and shock-proof jug art is very old. Many years before the application for the Blair patent was filed it was well known that to prevent breakage of frangible containers and to keep the contents of these containers from cooling or heating too quickly, they should be packed within an outer container and separated from it by shock and heat insulating material such as ground cork, sawdust, shavings, or corrugated board.

It was not new to suspend the inner container to the protective outer jacket at the neck by means constituting both a seal and a bond. Petitioner claims this as the dominant characteristic of the Blair invention (Brief, p. 15). One of respondent's experts, Mr. Johnson, its president, asserted that the suspending means or bond of the Blair patent could be either an adherent bond or a mechanical bond due to the interlocking of the inner container to the outer jacket through this bond (Rec., pp. 79, 80). If this is so there is no hope for the validity of Blair.

Mechanical interlocking bonds were old in Clisbee

(Rec. 360) and Heath (Rec. 356). Both a mechanical interlocking bond and a sealing bond are disclosed in the Steel patent No. 1,067,072 (Rec. 390) where the inner container 26 is suspended by its screw-threaded neck from the screw-threaded neck of the outer jacket 17. In lines 25-29 of page 2 of this patent it is mentioned that "cement or other well known means may be interposed between the threaded portions" to seal the same for forming an air-tight joint. Here in Steel is the dominant characteristic of the Blair invention. It was not cited previously by the courts as it was introduced for the first time in this suit.

The Heath, Clisbee and Fox (Rec. 366) references are sufficiently discussed in the earlier decisions of the Circuit Court of Appeals for the Seventh Circuit, 22 Fed. (2d) 93, 95. In the Bowman suit and again in the present one petitioner alleged that the plaster of Paris bond of Fox was neither a bond or seal and could not act as such. Both the Sixth Circuit and petitioner overlooked the fact that the bonds used by Macomb in the earlier suit and charged to infringe Blair were made from plaster of Paris and cement (Rec. 94). By charging infringement by this type of bond, petitioner must equally recognize a bond of this type as prior art. The Seventh Circuit rightly and properly adjudged that the Blair construction involved no invention over these three patents.

With the addition of Steel Patent No. 1,067,072 (Rec. 390) we have an anticipation of the Blair claims with the immaterial addition that Steel uses a partial vacuum as an additional heat insulating means. Claim 1, for instance, when read on Steel is as follows:

> (a) "A heat-insulated vessel of the non-vacuum type having an outer jacket of non-frangible ma-

terial," (Steel, Rec. 390, has the outer metal receptacle 17)

(b) "an inner container of frangible material," (Steel has the inner container 26 of glass)

(c) "said inner container being bonded to and pendently supported from said jacket," (Steel has container 26 bonded to and pendently supported by screw-threaded neck 28 to screw-threaded neck 23 of the outer receptacle with cement interposed therebetween)

(d) "and heat-insulating and shock-absorbing means surrounding said container for limiting oscillations of said container while permitting expansion thereof by changes of temperature." (Steel has the heat-insulating body 29 surrounding the container 26, lines 37-42, page 2. This is also a shock-absorbing means, lines 64-71, page 2. The space between containers is also made into a partial vacuum for additional heat insulation.)

If petitioner claims that Steel doesn't show comminuted material, *i. e.*, ground cork, sawdust, etc., would it involve invention to substitute these obvious equivalents in view of the use of this material by nearly everyone in the art for heat-insulating and shock-absorbing purposes? This is respondent's case.

That is the same case made by the Seventh Circuit in using Clisbee or Heath and substituting the obvious equivalent of Fox in the Macomb suit, 22 Fed. (2d) 93, 94. If the Sixth Circuit had realized that petitioner had charged a plaster of Paris bond as an infringement in the Macomb suit, it is doubtful if it would have rejected the Fox reference on the testimony of petitioner's witnesses when no cross-examination or briefs on the part of the defendant was available.

3.

Lack of Invention Is Properly Found From a Consideration of the Prior Art.

Petitioner has combined together the law regarding anticipation with the law relating to lack of invention and argues that, since the lower courts did not apply the law of anticipation to the findings of lack of invention, their decisions are in conflict with the weight of authority.

It cites three cases (Brief, 17) to support this argument. These cases refer to proof that patentee was not the first and original inventor (*Bates* v. *Coe*, 98 U. S. 31, 48) and to anticipations. No mention is made in these cases of lack of invention or mere mechanical skill in view of the art, or the substitution of equivalents. All of the decisions in the Seventh Circuit have dealt with the want of invention in Blair.

Proper authority for applying want of invention as done in the Seventh Circuit is to be found in *Vandenburgh* v. *Truscon Steel Co.*, 261 U. S. 6, 13, 14; 43 S. Ct. 331, 333, 334; in *John E. Thropp's Sons' Co.* v. *Seiberling*, 264 U. S. 320, 327; 44 S. Ct. 346, 349; and in *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 264 U. S. 445, 450, 451; 44 S. Ct. 533, 535, 536.

Lack of invention, according to these cases, may be considered from a review of all the prior art. There is nothing in the decisions of the lower courts in conflict with the weight of authority.

4.

As Limited By the Prior Art There Is No Infringement.

The Blair patent describes and shows only an elastic bond that will adhere or stick to a smooth surface such as glass or a vitreous surface. The prior art does not show this specific type of bond. Petitioner took out a separate patent on the material of this elastic, adhesive bond in Simonson and Blair Patent No. 1,309,967 (Rec. 413). This patent is not involved in this suit.

Respondent does not use this type of bond but instead uses a mixture of sulphur and cement that is brittle and will not adhere to a glass or vitreous surface (Rec. 103). There is nothing adhesive about this bond. It forms only a mechanical interlock as do the bonds of the prior art such as Steel 1,067,072.

If respondent's device infringes so does this prior art with its mechanical interlocking means. If limited to its adhesive, elastic bond, Blair is not infringed and it must be so limited to prevent actual anticipation. Whether this is invention is another question not before this court.

5.

The Question of Disclaimers Is Moot.

The case of *Triplett* v. *Lowell,* 297 U. S. 638; 56 S. Ct. 645, holds that where certain claims of a patent are held invalid the patentee may sue again upon those claims plus others without having to file disclaimers. The question of disclaimers is not considered by the court in the second suit if all the claims are found valid for there is nothing to disclaim. If part of the claims are held valid and part invalid the patentee

must disclaim before proceeding further in the same suit on the valid claims. Where, as here, the second court finds all the claims in suit invalid, that is all that is necessary for the affirmance of a decree dismissing the bill for want of equity (Rec. 325). For a reviewing court to go further and hold the entire patent invalid as to claims not even before it is unnecessary.

This court did not discuss the further possibility where the second tribunal finds some of the claims, previously adjudicated invalid, to be valid and others invalid over the prior art. Undoubtedly in such an instance the second tribunal must then pass upon delay in filing disclaimers.

It was proper for the District Court to make its findings and conclusions relative to delay in filing disclaimers to assist the reviewing court should this last contingency arise.

Conclusion.

The failure of the Circuit Court of Appeals for the Seventh Circuit to find with respect to the testimony of Brainard and Terry as did the Circuit Court of Appeals for the Sixth Circuit is not such a conflict as to justify the grant of certiorari, especially as the facts were different in the two circuits. Confronted with the failure of this ground to support the application, petitioner joins the question of disclaimer. As there is no conflict of decision as to this question, this ground likewise should fail.

It is respectfully urged that the petition should be denied.

Respectfully submitted,

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